

Applicant: Pekka Koivukunnas et al.
Application No.: 10/069,203
Art Unit: 1731

Remarks

Claims 7-14 remain pending in the application. Claims 1-6 were canceled by a Preliminary Amendment. It is noted that the Office Action Summary refers to claims 1-3 as pending, however, in the Detailed Action the Examiner refers to claims 1-6 as being rejected. Acknowledgment that claims 7-14 are pending is requested. In the Office Action dated March 26, 2003, claims 1-6 [*sic*] [7-14] were rejected as being obvious over *JP 5331793* in view of *Bubik et al.*

JP 5331793 does not show a shoe or extended-nip calendering unit placed after a Yankee cylinder, but rather a soft calendar comprising a metallic roll and an elastic roll having a Shore D hardness of 80-96 degree. The Examiner suggests it would have been obvious to employ an extended nip calendar as the calendering step in *JP 5331793* because *Bubik et al.* teaches that "extended nip (shoe) calendering does not require asymmetric moisture profile to achieve desired smoothening of the paper surface." this suggestion of *Bubik et al.* merely supports the possibility of the invention which applicant has made, it does not teach the invention. The disclosure of *Bubik et al.* is not sufficient to make obvious the replacement of the soft calendar of *JP 5331793* with a shoe or extended nip calendar. There must be some suggestion to do what applicant has done and *Bubik et al.* does not suggest placement of the device immediately after a Yankee dryer.

There must also be some motivation or suggestion, found within the prior art references themselves, of the desirability of doing what the inventor has done. The examiner has used as the basis for the rejection a retrospective reading of *Bubik et al.* with the invention as blueprint, such a retrospective view, is improper. Obviousness must be determined at the time of the invention, without the use of the insight provided by applicant's disclosure as to what is desirable.

If the references do not expressly or impliedly suggest the claimed invention, the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. Further, the examiner must show not only a teaching or suggestion to make the claimed combination

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but a reasonable expectation of success which is found in the prior art, and not based on applicant's disclosure.

Placing a shoe or extended-nip calender unit immediately after a Yankee cylinder has the following advantages over the use of a soft calender: the speed of the Yankee cylinder can be increased beyond that which can be achieved with a soft nip calender, greater drying capability can be achieved as compared to a soft nip calender, and greater web speed can be achieved because of the greater drying capabilities resulting in greater economic efficiency. Nip size/dwell time can be extended irrespective of the nip load, or the diameter of the press roll. Increasing nip width without necessarily increasing the pressure, preserves paper thickness which influences paper stiffness, while allowing formation of greater gloss on the web surface.

The examiner has not made out a *prima facie* case of obviousness because neither *JP 5331793* nor *Bubik et al.* suggests the use of a shoe or extended-nip calendering unit immediately after a Yankee cylinder and the examiner has not provided a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references and has not shown within the prior art a reasonable expectation of success.

Applicant submits that the claims are in condition for allowance. Favorable action thereon is respectfully solicited.

Respectfully submitted,



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